

REMARKS

Reconsideration is respectfully requested in light of the foregoing Amendment and remarks that follow.

Claims 1-7 are before the Examiner.

Claim 1 has been amended in response to the Examiner's objection. Support for the amendment appears in the original claims and in the specification as filed.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by CA (2,223,377). Applicants respectfully traverse.

A reference to be anticipatory must teach each and every element required by the claim. Here the claims require that the pyrogenic oxides doped with potassium have a breadth of the distribution of particle size of at least 0.7 (an advantage in chemical mechanical polishing procedures).

Mangold et al do not expressly teach the claimed breadth of the particle size distribution. This the Examiner recognizes in the Office Action (Note first complete paragraph on page 3 of the Official Action.). The Examiner appears to be of the opinion that Mangold et al. must inherently achieve this distribution. The Examiner would appear to argue that the experimental conditions are the same and therefore the claimed results should be inherently achieved. A careful review of Example 5, referred to by the Examiner in the Office Action, and a comparison with the instant examples directed to the invention suggest differences, in particular note the concentration of potassium chloride employed.¹ In contrast to Example 5 of the reference (Mangold et al. CA (2,223,377)), which employs 0.5%, Example 2 employs 12.5%; Example 3 employs 2.22%; the remaining examples employ multiples of the amount employed in Example

¹ The process of the art is a pyrogenic one that means that a mixture of SiCl₄, H₂, O₂ and aqueous solution of HCl was burned in a flame. The result is a product with a large particle size distribution. There is no hint in the references how to produce a monodispersed silicon dioxide doped with potassium. The silicon dioxide shows a grindometer-value of 60 μ m.

3. See Table 1. The concentrations are significantly different. The product described by Mangold et al (Applicants) in the instant specification (See Table 2) is clearly different than that described in the Canadian Patent. Note the pH values for the instant product are basic (Note Table 2) while that in the Canadian Patent is acidic (Note Table 2 on page 14). There are other comparable differences. The different process conditions result in different products.

The test with inherency is that it must be reasonably certain that the material would possess the characteristic. More than speculation as to the existence of the characteristic is required. Similar processing conditions is sometimes sufficient to suggest the inherent presence of the characteristic in similar products. That is not the case here. The processing conditions are different. The products are different not the same.

Here, in the silicon dioxide according to the invention, the potassium is distributed equally in the silicon dioxide. It is not possible to locate the potassium on the EM-photographs. Further, the particles of the invention are spherical, round primary particles, which are not linked together. No structure can be estimated by the DBP-Method. See Figure 6 (Example 3).

Since the claim characteristic for particle distribution is not taught and the products are prepared under different conditions and are different, there is no anticipation. Withdrawal of the rejection is respectfully requested.

Claims 1-7 are rejected under 35 U.S.C. 103 (a) as being unpatentable over '377.

Applicants respectfully traverse.

The deficiencies of Mangold et al. are discussed above. No reference is cited to remedy these deficiencies.

Rather, the Examiner urges that it would be obvious to make a monodispersed product. He urges that such products are “well known and concentrated in the art”. The Examiner does not suggest how this end would be achieved nor does he cite any art suggesting the desirability of monodispersed product like those claimed. Reliance on Applicants' own specification for these teachings is not permitted.

It is respectfully submitted that a proper prima facie case has not been established. The teachings of the art relied upon are incomplete relative to the claims. Accordingly, withdrawal of the rejection is respectfully requested.

In view of the foregoing amendments and remarks, the application is believed to be in condition for allowance and a notice to that effect is respectfully requested.

Should the Examiner not find the Application to be in allowable condition or believe that a conference would be of value in expediting the prosecution of the Application, Applicants request that the Examiner telephone undersigned Counsel to discuss the case and afford Applicants an opportunity to submit any Supplemental Amendment that might advance prosecution and place the Application in allowable condition.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas G. Wiseman', is written over a horizontal line.

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